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Remarks

As a preliminary matter, Applicants wish to note that the VESTOPLAST product literature submitted with the Preliminary Amendment and the VESTOPLAST literature received from the Patent Office as an attachment to the September 14, 2004 Office action are not prior art to the present application. There is no evidence of record establishing anything to the contrary. Therefore, Applicants request that the later be removed from the listing on the Notice of References Cited, Form PTO-892. Applicants herein treat the pieces of VESTOPLAST literature as non-prior art references.

It is Applicants' understanding that the previous rejection of record, i.e., claims 2-12, 33-36, 38-42, 44, and 46-59 under 35 U.S.C. § 103 over EP 315,013 in view Maletsky et al. and further in view of Smith et al. and optionally further in view of Buell, has been overcome by Applicants' Preliminary Amendment as that rejection has not been maintained in the September 14th Office action.

Claims 2-12, 33-36, 38-42, 44, and 46-64 stand rejected under 35 U.S.C. § 103 over Maletsky et al. in view of EP 315,013 and further in view of Smith et al. and optionally further in view of Buell.

Maletsky et al. disclose hot melt compositions. The one example composition disclosed by Maletsky et al. is a hot melt adhesive blend that includes hydrocarbon resin, amorphous polypropylene, antioxidant and crystalline polypropylene, and has a melt viscosity of 11,000 cps at 325°F (i.e., 162.8°C).

EP 315,013 discloses a method of making a diaper that includes coating a thermoplastic polymer material onto a web by means of a surface nozzle or an application roller.

Smith et al. disclose a hot melt extrusion coating process that includes extruding a random copolymer of ethylene and acrylic acid at a temperature of about 105°C to about 250°C in the form of a thin film that is deposited on a substrate.

Buell et al. disclose a method of bonding a porous web to a substrate. The Buell et al. method includes applying a discontinuous hot melt adhesive to a porous fibrous web by direct contact extrusion.

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Claim 10, the first independent claim, is directed to a method of forming a continuous film layer of a thermoplastic composition onto a substrate. The method includes providing a molten thermoplastic composition, advancing a web along a path, dispensing a continuous film of the thermoplastic composition from a coating device at a coating temperature where the thermoplastic composition has a complex viscosity of less than about 500 poise at about 1000 radians/seconds at the coating temperature and a complex viscosity ranging from about 100 poise to about 1,000 poise at about 1 radian/second at the coating temperature, suspending the film between the coating device and the web, and contacting the film with the advancing web. The thermoplastic composition is released from the coating device at a temperature of less than about 160°C. To establish a *prima facie* case of obviousness based upon a proposed combination of references there must be a teaching, suggestion or motivation in the prior art for making the proposed combination. See M.P.E.P. 2142; *Fromson v. Anitec Printing Plates, Inc.*, 132 F.3d 1437 (Fed. Cir. 1997); *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, (Fed. Cir. 1998). In addition, there must be a reasonable expectation of success. M.P.E.P. 2142. The suggestion or motivation to make the claimed combination and the reasonable expectation of success must both be found in the prior art and must not be based on Applicants' disclosure. See M.P.E.P. 2142. In addition, in order to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method. *Beckman Instruments, Inc. v. LKB Produkter AB*, 892 F.2d 1547, 1551 (Fed. Cir. 1989), *citing In re Payne*, 606 F.2d 303, 314 (CCPA 1979). Here there is no such teaching, suggestion or motivation for making the combination proposed in the outstanding Office action, or reasonable expectation of success. In addition, the proposed combination fails to enable the skilled artisan to make and use the claimed method.

It is undisputed that Maletsky et al. do not teach a coating method that includes dispensing a continuous film of thermoplastic composition from a coating device and suspending the film between the coating device and the substrate. Maletsky et al. disclose that the compositions of their Examples were applied to a substrate using an extrusion coating method. Maletsky et al. do not provide any additional information about this extrusion coating method.

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EP 315,013 also does not teach a coating method that includes dispensing a continuous film of thermoplastic composition from a coating device and suspending the film between the coating device and the substrate. The September 14th Office action takes the position that the skilled artisan would have appreciated that the surface nozzle depicted in EP 315,013 is spaced a distance away from the web of EP 315,013, and cites Smith et al. and Buell in support of this position. However, if the surface nozzle of EP 315,013 were spaced away from the surface of the web of EP 315,013 a distance sufficient to suspend a film of thermoplastic between the surface nozzle and the web, the method of EP 315,013 would be inoperable for its intended purpose. In particular, if the surface nozzle of the coating method depicted in FIG. 2 of EP 315,013 were moved away from the web so as to be spaced a distance apart from the web and so as to allow one to attempt suspending a thermoplastic film between the coating device and the moving web, then the thermoplastic being released from the surface nozzle of EP 315,013 would fall to the ground due to the force of gravity. The law of gravity is a well-known scientific fact. The effect of gravity on a thermoplastic being released from a surface nozzle positioned as depicted in FIG. 2 of EP 315,013 has been demonstrated through the previously submitted Declaration of George Brown. In particular, the thermoplastic accumulates at the nozzle and falls to the ground.¹ Thus, if the surface nozzle of EP 315,013 were positioned from the web a distance sufficient to suspend a film of thermoplastic between the surface nozzle and the web, the method of EP 315,013 would be inoperable.

EP 315,013 also fails to enable the method of claim 10. If the surface nozzle of EP 315,013 were spaced a distance apart from the web so as to allow for the suspension of a thermoplastic film between the coating device and the moving web of EP 315,013, then EP 315,013 would need to teach how to form a continuous thermoplastic film without contact between the surface nozzle and the web, how to contact the film with the moving web, and how to form a continuous film layer of thermoplastic on the web, which EP 315,013 does not. EP 315,013 does not teach or suggest how a thermoplastic composition released from the surface nozzle would form a continuous film or how the web would contact the film the web if the surface nozzle were spaced a sufficient

¹ The fact that the web referred to in Mr. Brown's Declaration moved in a different direction is irrelevant to the effect of gravity on a thermoplastic issuing from the surface nozzle.

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distance apart from the web to allow suspending a film between the coating device and the web. Therefore, EP 315,013 does not enable a coating method in which a coating device is spaced a distance apart from a web, and further fails to enable a coating method that includes suspending a thermoplastic film between the coating device and a web.

Regarding Smith et al. and Buell, the Office action repeatedly admonishes that Smith et al. and Buell are not cited to cure the deficiencies of Maletsky and EP 315,013 (see, September 14th Office action, page 15, first full paragraph). Rather, according to the Office action 1) Smith et al. is cited "just to suggest and evidence that there would have been a gap between the nozzle exit and the nonwoven in the processing of Maletsky and EP 315013" (September 14, 2004, Office action, page 15), and 2) Buell is cited as "further evidence[] that there was a gap between the nozzle and the nonwoven in the operation [of EP 315,013]." *Id.*, page 16. Therefore, because the Office action does not rely on Smith et al. and Buell to cure the deficiencies of Maletsky and EP 315,013, it cannot be disputed that Smith et al. and Buell fail to cure the deficiencies of Maletsky and EP 315,013. Therefore a *prima facie* case of obviousness of claim 10 has not been made. Accordingly, Applicants submit that the rejection of claim 10 under 35 U.S.C. § 103 over Maletsky et al. in view of EP 315,013 and further in view of Smith et al. and optionally further in view of Buell is unwarranted and request that it be withdrawn.

Claims 2-9, 11, 12, 33-36, 38-42, 44, and 46-64 are distinguishable over the proposed combination of Maletsky et al. in view of EP 315,013 and further in view of Smith et al. and optionally further in view of Buell for at least the same reasons set forth above in distinguishing claim 10. Accordingly, Applicants request that the rejection of claims 2-12, 33-36, 38-42, 44, and 46-64 under 35 U.S.C. § 103 over Maletsky et al. in view of EP 315,013 and further in view of Smith et al. and optionally further in view of Buell be withdrawn.

Applicants now take this opportunity to clarify the record.

The Office action states, "With respect to the use of the 'surface nozzle', the applicant is advised that the 'gap' for which their own films are suspended is as small as 0.5 mm and thus the exit of the nozzle would have been understood to have been close to the surface of the substrate." September 14th Office action, page 3. The Office action impermissibly relies on Applicants' Specification to define the distance over which the

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coating is allegedly suspended between the coating device and the web of EP 315,013. Applicants' Specification is not part of the prior art. As has been established above, EP 315,013 does not teach a spacing between the coating device and the web --let alone a spacing sufficient to allow suspending a continuous film of thermoplastic composition between a coating device and the web.

The Office action next asserts, "[EP 315,013] made it clear that those skilled in the art at the time the invention was made knew it was desirable to provide a thin coating upon a nonwoven wherein the coating was continuous and pinhole free." September 14th Office action, page 2. The September 14th Office action further asserts, "If holes in the film had been acceptable, then the film would not have sufficed as a liquid barrier." *Id.*, page 2. EP 315,013 does not teach a continuous coating. EP 315,013 also does not teach a pinhole free coating. Nowhere in EP 315,013 is there a mention of a continuous coating or a pinhole free coating. Rather, EP 315,013 discloses that the coating is moisture impermeable and air permeable. EP 315,013 explains, "the outer layer remains moisture-impermeable, but it becomes gas-permeable, especially air-permeable --it can 'breathe' -so that the free air exchange is possible" EP 315,013, page 3. For a coating to be air permeable it must include holes. Thus, the barrier layer of EP 315,013 must include holes of a size sufficient to allow air to pass there through. There is no evidence of record establishing that a coating with holes of a size sufficient to allow air to pass there through would not also function as a liquid barrier. Accordingly, since the coating of EP 315,013 must include holes, it cannot be a continuous film.

The Office action further asserts, "Note that the reference [EP 315,013] described [sic] a continuous thin pinhole free coating upon a nonwoven and one would have expected that such would have been applied without contact with the nonwoven as the fibers of the same would tend to break the film apart upon application." September 14th Office action, page 3. The Office action cites no support or evidence establishing the veracity of these statements. In particular, there is no evidence of record establishing that a film must be applied without contact with a nonwoven to achieve a continuous pinhole free coating. Therefore these statements are opinion. Opinion is not a proper basis for a rejection. Moreover, as established above, EP 315,013 does not disclose a pinhole free coating. To the contrary, EP 315,013 discloses a coating. EP 315,013 also discloses that

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the coating is air permeable. Since it is air permeable, it necessarily includes holes. As a result, the evidence does not support the assumptions on which the Office action relies to reach the conclusion set forth above.

Claims 3 and 4 stand rejected under 35 U.S.C. § 103 over EP 315,013 in view of Maletsky et al. '202 further in view of Smith et al. and optionally further in view of Buell taken with Waggoner or UK 688,637.

The discussion of EP 315,013, Maletsky et al., Smith et al. and Buell set forth above is incorporated herein.

Waggoner discloses coating glassine paper with a polyolefin film. Waggoner discloses a process in which a molten film is passed into a nip between a chill roll and a pressure roll.

UK 688,637 discloses applying a film of a synthetic linear polymer of sharp melting point to a sheet by inserting the film into a nip.

Claim 3 depends from claim 10 and further discloses that the coating device is spaced from the path of the web a distance between about 0.5 mm and about 20 mm. Claim 4 depends from claim 3 and further discloses that the distance between the coating device and the web is less than about 10 mm. Neither EP 315,013 nor Maletsky et al. teach or suggest spacing a coating device from the path of a web. Smith et al. also do not teach or suggest spacing a coating device oriented as depicted in EP 315,013 from the path of a web. Rather, the method of Smith et al. employs a coating device positioned vertically above a nip such that a film is deposited vertically into a nip. Nothing in Smith et al. teaches or suggests that if a coating device, oriented as depicted in EP 315,013, were spaced from the web, coating of a web could be achieved. Therefore, the skilled artisan would find Smith et al. to have no bearing on the method of EP 315,013. Moreover, because Smith et al. do not teach how to coat a web with the coating device of EP 315,013 spaced a distance apart from the web, the skilled artisan would have no reason to look to Smith et al. and would have no clue as to how to do so. The proposed combination of EP 315,013, Maletsky et al. and Smith et al. thus also fails to enable the methods of claims 3 and 4.

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Buell does not cure the deficiencies of EP 315,013, Maletsky et al., and Smith et al. Buell does not teach or suggest spacing the coating device from a web. Rather the coating device of Buell is in contact with the web.

Waggoner also does not cure the deficiencies of the EP 315,013, Maletsky et al., Smith et al, and optionally Buell. Waggoner discloses vertically passing a film into a nip formed by two rollers. Waggoner does not teach or suggest anything about the spacing of a coating device relative to an advancing web for a method in which the coating device is oriented as depicted in EP 315,103. Therefore, the skilled artisan, familiar with EP 315,013, would have no reason to look to Waggoner, would find Waggoner to have no relevance to the method of EP 315,013, would have no reason to modify the method of EP 315,013, and would have no reasonable expectation of achieving a successful coating method by modifying the method of EP 315,013. Moreover, nothing in Waggoner teaches or suggests how the method of EP 315,013 would achieve its intended purpose if the coating device of EP 315,013 were spaced a distance apart from a web. Thus, the proposed combination of EP 315,013, Maletsky et al., Smith et al. and Waggoner also fails to enable the method of claims 3 and 4.

UK 688,637 also does not cure the deficiencies of the EP 315,013, Maletsky et al., Smith et al, and optionally Buell. UK 688,637 discloses vertically passing a film into a nip between two rollers. UK 688,637 does not teach or suggest anything about the spacing of a coating device relative to an advancing web for a method in which the coating device is oriented as depicted in EP 315,103. Therefore, the skilled artisan, familiar with EP 315,013, would have no reason to look to UK 688,637, would find UK 688,637 to have no relevance to the method of EP 315,013, would have no reason to modify the method of EP 315,013, and would have no reasonable expectation of achieving a successful coating method by modifying the method of EP 315,013. Moreover, nothing in UK 688,637 teaches or suggests how the method of EP 315,013 would achieve its intended purpose if the coating device of EP 315,013 were spaced a distance apart from a web. Thus, the proposed combination of EP 315,013, Maletsky et al., Smith et al. and UK 688,637 also fails to enable the method of claims 3 and 4. For at least the reasons set forth above, a *prima facie* case of obvious of the method of claims 3 and 4 has not been made. Accordingly, Applicants submit that the rejection of claims 3

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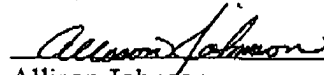
and 4 under 35 U.S.C. § 103 over EP 315,013 in view of Maletsky et al. '202 further in view of Smith et al. and optionally further in view of Buell taken with Waggoner or UK 688,637 is unwarranted and request that it be withdrawn.

The claims now pending in the application are in condition for allowance and such action is respectfully requested. Should the next action be other than allowance, Applicants respectfully request an interview with the Examiner to discuss the same.

Please charge any additional fees owing or credit any over payments made to Deposit Account No. 06-2241.

Respectfully submitted,

Date: December 14, 2004


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